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09/816,227	03/26/2001	Masahide Tanaka	108855	5802
25944	7590	07/06/2005	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			RIMELL, SAMUEL G	
			ART UNIT	PAPER NUMBER
			2165	

DATE MAILED: 07/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/816,227

Applicant(s)

TANAKA, MASAHIDE

Examiner

Samuel Rimell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 April 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-28, 34, 35, 40, 41 and 45-47 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28, 34, 35, 40, 41, 45-47 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

RD

### DETAILED ACTION

This action is responsive to the applicant's amendment filed on 4/29/2005.

Claims 1, 4, 5, 8, 14, 22-28, 34, 35, 40, 41 have been amended, and claims 29-33, 36-39, and 42-44 have been canceled without prejudice or disclaimer.

Claims 1-28, 34, 35, 40, 41, and 45-47 are pending and presented for examination.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-16, 18, 22-24, 41, and 45-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Takada (U.S. Patent 5,146,604).

Claim 1: FIG. 1 illustrates a system in which a memory structure (2b) stores information. The information is digital image data (col. 2, lines 26-33).

FIGS. 9-10 illustrate a recoding mechanism which records a history use (number of searches and search day). FIG. 10 is the recording mechanism for memory structure (2b) while FIG. 9 has the same recording mechanism for another memory structure (2a).

The controller is the controller structure (6) in Fig. 1. This controller controls the number of digital images that may be provided in the memory unit (2b). If the search frequency goes down for images in memory (2b) they are erased from memory (2b). If the search frequency goes up for images in memory (2a) they are transferred to memory 2b (See col. 5, lines 25-48). Thus the number of images in memory (2b) are controlled by the controller, so that the number of popular images is controlled so as to be greater and the number of non-popular images is controlled so as to be a lesser number or zero.

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Claim 2: The condition is the number of images in memory (2b) and this is directly controlled by the controller (6).

Claim 3: The recorders (FIGS. 9-10) record the number of "orders", which is readable as the number of searches for a particular image.

Claim 4: The movement of popular images to the memory (2b) and erasure of unpopular images in memory (2b) is performed when the recorded lists are compared. The period of time between these comparisons is the predetermined period.

Claim 5: Images that are more popular are either retained or moved to the memory (2b). Accordingly, memory (2b) allows a greater number of the popular images to be stored in its memory space.

Claim 6: If the number of searches (orders) for an image increases, the images may be transferred into the memory space (2b). In this case, the number of those particular images in memory space (2b) increases (col. 5, lines 25-48).

Claim 7: If the number of searches (orders) for an image decreases, the images may be deleted from memory space (2b). In this case, the number of those particular images decreases (col. 5, lines 25-48).

Claim 8: The searcher is the programming of the controller which causes the recorded information in FIGS 9-10 to be compared for changes in search frequency.

Claim 9: The "given condition" is a change in the frequency of searches for an image. The frequency of searches directly correlates to a number of orders for a search, since actual search on a document is considered an order for that document.

Claims 10-11: The "given condition" is a change in the frequency of searches for that given image. The given condition may apply to a popular document or unpopular (unappreciated) document.

Claim 12: The "given condition" is enforced on the images, which are inherently provided by some provider source.

Claim 13: See remarks for claim 10.

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Claim 14: An image whose frequency of search reduces is erased from memory (2b) and may be replaced by a "fresh image" whose popularity has increased and is transferred into memory (2b). See also col.2, line 60 an image information is newly stored.

Claim 15: The printed matter printed matter production system is the overall system of FIG. 1 since this system is capable of storing and printing images (col. 2, lines 15-47).

Claim 16: In FIG. 1, the print unit (4) is the acceptor since it accepts data that is designated to be printed.

Claim 18: The proposer is the display unit (3, FIG. 1). The acceptor is the printer (4, FIG. 1). The controller (6, FIG. 1) is the decider that sends print commands for images to be printed.

Claim 22: See remarks for claim 1. The step of informing is displaying images on the display screen (3) while the step of accepting orders is the step of performing a search on an image, which is recorded by the recording tables of FIGS. 9-10. See also col.2, line 60 an image information is newly stored.

Claim 23: See remarks for claim 2-3.

Claim 24: The memory is system (2b). The recorder is the tables of FIGS. 9-10. The searcher is the controller (6) which compares the tables of FIGS. 9-10 to look for changes in search frequency for given images.

Claim 41: See remarks for claim 1.

Claims 45-47: FIGS. 9-10 illustrate a recoding mechanism which records a history use (number of searches and search day). FIG. 10 is the recording mechanism for memory structure (2b) while FIG. 9 has the same recording mechanism for another memory structure (2a).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17, 19, 20, 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takada O-J.S. Patent 5,146,604) in view of Nishikawa (U.S. Patent 6,421,141).

Claims 17, 19, 20, 21: Each of the claims in this group differ from Takada in that they do not disclose multiple printers or a printer selector. However, Nishikawa provides for an algorithm which permits the selection of one printer from a group of individual printers, based on desired color reproduction capabilities. (col. 10, lines 39-47 of Nishikawa). It would have been obvious to one of ordinary skill in the art to modify the system of Takada to include multiple printers and a printer selector so as to enhance available options for color reproduction of images as taught by Nishikawa.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 24-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohsawa et al. (U.S. Patent 6,509,900) in view of Takada O-J.S. Patent 5,146,604).

Claim 24: Ohsawa et al. discloses a memory device (HDD device) that stores a plurality of digital images. The entities which provide the images are inherently image providers. The system includes an image server (102) that performs the programmed functions illustrated in FIGS. 2-3. At step S205 a block of programming acts as a recorder and records the popularity of a given image which has been requested for retrieval. At steps 5300-S306 in FIG. 3, a block of programming acts as a controller to control a condition. One such condition is the amount of memory space available on the high speed HDD retrieval device. The

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users (100, 101) are the searchers that search for image data. Ohsawa et al. differs in that it does not include the recorder for recording a history of use, the history of the use including a total number of orders for all the image data provided by each of the plurality of image providers; provided by one or more of the plurality of image providers that meets a given condition set on the history recorded by the recorder. However, Takada FIGS. 9-10 illustrate a recoding mechanism which records a history use (number of searches and search day). FIG. 10 is the recording mechanism for memory structure (2b) while FIG. 9 has the same recording mechanism for another memory structure (2a). It would have been obvious to one of ordinary skill in the art to modify the system of Takada to include a recording mechanism which records a history use (number of searches and search day) as taught by Takada in the programmed functions of Ohsawa illustrated in FIGS. 2-3. At step S205 a block of programming acts as a recorder and records the popularity of a given image which has been requested for retrieval to permit to record the history of use in daily basis.

Claim 25: The condition is the amount of available memory space on the HDD. This condition is changed based upon the popularity of images, which correlates to the number of orders for those images. For example, less popular images can be erased, thus changing the available space condition.

Claim 26: The given condition is the available space on the HDD. This space is controlled by a relationship between popular images and unpopular images. The most popular images are supposed to be located on the HDD, and the CD-ROM changer is supposed to contain a copy of all the images, so how the search is fulfilled depends upon how popular an image actually is. More popular images are found on the HDD and less popular images are found on the CD-ROM changer.

Claim 27: The first condition of available memory space on the 1-IDD is imposed on image providers, since image providers cannot provide more images that physical space permits.

Claim 28: See remarks for claim 26.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 34, 35, 40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohsawa et al. (U.S. Patent 6,509,900) in view of Nishikawa (U.S. Patent 6,421,141).

Claim 34-35: Ohsawa et al. stores digital images in the CD-ROM changer and HDD system. Displaying to the users (100, 101) the images which are available is the step of proposing optional digital image data. Having the users select images for downloading is the step of accepting selections. Ohsawa et al. differs in that it does not include specifications for printers used by the users (100, 101). However, Nishikawa discloses a digital image processing and printing system such that could be used by users (100, 101) of Ohsawa et al. FIG. 13, parts 618-620 of Nishikawa provides for an algorithm which permits the selection of an individual printer, based on the desired color reproduction capabilities (col 10, lines 39-47 of Nishikawa). Having the users use an algorithm from Nishikawa to select the printers for printing is the step of producing the printed matter. It would have been obvious to one of ordinary skill in the art to modify each of the user stations (100, 101) to include multiple printers and capabilities for selecting a desired printer so as to enhance the available options for color reproduction as taught by Nishikawa.

Claim 35: See remarks for claim 34. Further note that the system at the user location in Ohsawa et al. can change the selection of printer using the algorithm of Nishikawa.

Claim 40: The system of Ohsawa et al. stores digital images. The digital images are proposed to users (100, 101) and selections of digital images are made by those users. Ohsawa et al. differs in that it does not include specifications for printers used by the users (100, 101). However, Nishikawa et al. discloses a set of printers and printer selector for printing the digital images at the user site. Further note that selection changes can be made in the sense that printer selections can be changed. It would have been obvious to one of ordinary skill in the art to modify Ohsawa et al. to include the printers and printer selector of Nishikawa for the reasons already recited herein.

Remarks

Applicant's arguments filed on 4/15/2005 with respect to claims 1-28, 34, 35, 40, 41, and 45-47 have been fully considered but they are not persuasive, for the reasons set forth below. (See the rejection above).

The Examiner has completed a through study of the applicant's arguments. These arguments have been fully considered but they are not persuasive.

Applicant argued that the cited reference Takada does not disclose a controller that controls a storing condition for each image provider by designating, based on the history of use recorded by the recorder, at least one of an amount of memory space that each image provider may utilize or a number of digital image data each image provider may store in the memory as recited in independent claims 1, 22, and 41.

In response to the Applicant's arguments, the examiner respectfully disagrees because Takada discloses in figure 1 component 6 a controller that controls a storing condition for each image provider and updates the content of extent memory unit 5 (See Takada Fig.1 col.2, line 19, lines 56-59), with respect of the limitations based on the history of use recorded by the recorder, Takada FIGS. 9-10 illustrate a recording mechanism which records a history use (number of searches and search day). FIG. 10 is the recording mechanism for memory structure (2b) while FIG. 9 has the same recording mechanism for another memory structure (2a), which correspond to the history of use of history of orders.

Furthermore, Applicant argued that Ohsawa does disclose a recorder that records a history of use, the history of use including a total number of orders for all the images data provided by each of the plurality of image providers. Examiner respectfully disagrees because claim 24 is now rejected in combination of Ohsawa and Takada wherein the combination of Ohsawa and Takada, as modified, discloses the claimed invention as required under 35 U. S. C. 103 (a) (See claim 24 rejection above).

Applicant argued that the combination of Ohsawa and Nishikawa fails to disclose or suggest proposing a plurality of groups of optional digital image data or element for selection by plurality of users and accepting the selections as recited in claims 34, 35 and 40. In response to the Applicant's arguments, the

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examiner recognizes that references can not be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination such as Ohsawa and Nishikawa as primary and secondary references. *In re Nomiya, 184 USPQ 607 (CCPA 1975)*. Ohsawa et al. stores digital images in the CD-ROM changer and HDD system. Displaying to the users (100, 101) the images which are available is the step of proposing optional digital image data and, Nishikawa provides for an algorithm which permits the selection of an individual printer, based on the desired color reproduction capabilities (col 10, lines 39-47 of Nishikawa) that could be used by users (100, 101) of Ohsawa. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. *In re Bozek, 163 USPQ 545 (CCPA 1969)*. In this case, It would have been obvious to one of ordinary skill in the art to modify each of the user stations (100, 101) to include multiple printers and capabilities for selecting a desired printer so as to enhance the available options for color reproduction as taught by Nishikawa.

Therefore, the examiner asserts that the combination of Ohsawa et al. and Nishikawa disclose or suggest the subject matter broadly recited in claims 34, 35 and 40 as required under 35 U. S. C. 103 (a).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

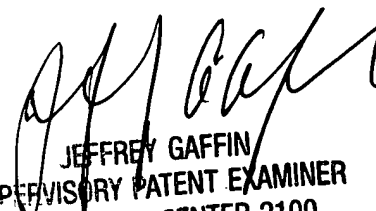
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel Rimell whose telephone number is (571) 272-4084.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Gaffin can be reached on (571) 272- 4146. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
JEFFREY GAFFIN  
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Sam Rimell

June 30, 2005